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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,977

12/02/2005

Peter Wachtler

CH8339/LeA 36,419

7549

7590

03/19/2008

Lanxess Corporation  
Law & Intellectual Property Department  
111 Ride Park West Drive  
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EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,977	<b>Applicant(s)</b> WACHTLER ET AL.	
	<b>Examiner</b> MARCOS SZNAIDMAN	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 pages / 11/13/2006</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This office action is in response to application # 10/533,977 filed on 12/02/2005.

### ***Status of Claims***

Claims 1-8 are currently pending and are the subject of this office action.

Claims 1-8 are presently under examination.

### ***Priority***

The present application is a 371 of PCT/EP03/11884 filed on 10/25/2003, and claims priority to foreign application GERMANY 102 51 915.3 filed on 11/08/2002.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4 and 5 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 provide for the use of “a mixture as claimed in at least one of claims 1 and 2 for protecting industrial materials”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Anker et. al. (EP 1245153 A2, cited by applicant, machine translated).

Claim 1 recites a mixture of tetramethylolacetylenediurea (TMAD) and 1,2-benzisothiazoline (BIT).

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For claim 1, Anker et. al. teach a mixture of tetramethylolacetylenediurea (TMAD) and 1,2-benzisothiazoline (BIT) (see example 3 on page 7).

Claim 2 recites the same limitations as claim 1, wherein the ratio of BIT to TMAD is from 9:1 to 1:9.

For claim 2, Anker et. al. teach a ratio of BIT to TMAD of  $30:125 = 1:4.16$  (see table 3 on page 8).

Claim 3, recites the same limitations as claims 1 and 2, further comprising at least one auxiliary from the group of solvents, or solvent mixtures, extenders, surfactants and, if appropriate, further antimicrobially active compounds.

For claim 3, Anker et. al. teach that the mixture can further contain solvents (see paragraphs [0019] and [0020]). The mixture can further contain further biocides (see paragraph [0024] and [0025]).

Claim 6, recites a method for protecting industrial materials against attack and/or destruction by microorganisms, by treating them with a mixture of claim 1 or 2.

For claim 6, Anker et. al. teach that the mixture can be used on very different fields. It is suitable for example for the inset in paints, flashes, adhesives, photo chemicals, fuels, cleaning agents, cosmetic products, etc against the infestation with bacteria, funguses, yeast and algae (see paragraph [0031]).

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Claim 7, recites a process for preparing a mixture as claimed in one of claims 1 or 2.

For claim 7, Anker et. al. teach a method for preparing the mixture (see paragraph [0023]).

Claim 8 recites an industrial material, comprising an active compound mixture as claimed in at least one of claims 1 and 2.

For claim 8, Anker et. al. teach a mixture of tetramethylolacetylenediurea (TMAD) and 1,2-benzisothiazoline (BIT) (see example 3 on page 7).

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLS  
February 27, 2008

/Michael P Woodward/  
Supervisory Patent Examiner, Art  
Unit 1615